

9/17/88

R-1988-7

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

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|------------|---|----------------------|
| In re |) | Decision on Petition |
| Petitioner |) | for Review under |
| <hr/> |) | Rule 10.2(c) |

, hereinafter petitioner, requests review under 37 CFR 10.2(c) of the Reconsideration of Decision on Request for Regrade of the afternoon section of the examination held on October 6, 1987, which was rendered on June 3, 1988 by the Director of the Office of Enrollment and Discipline (OED), hereinafter Director. Petitioner seeks an award of at least five points to his score to give him a passing grade.

BACKGROUND

Petitioner took the examination for registration to practice before the Patent and Trademark Office on October 6, 1987. He previously passed the morning section but received less than the minimum 70 points (out of 100) on the afternoon section necessary to be registered. A request for regrading on all the questions was received by OED on March 16, 1988. In his decision on the request, the Director added 2 points for question 1, 4 points for question 2, 10 points for question 3, and no points for questions 4-6. This resulted in a total score of 63 points although the Director indicated that the total was 65 points. A request for reconsideration was filed on April 22, 1988, but no additional credit was given by the Director in his decision of June 3, 1988. On June 21, 1988, this petition was filed seeking 4 points on question 2, 5 points on question 5 and 3 points on question 6.

FACTUAL REVIEW

Question 2

This question asks for the preparation of an information disclosure statement. A number of patents and various activities of the coinventors were to be considered for inclusion in this statement.

The initial grader deducted 8 points (out of 15). On review, the Director added 4 points because petitioner's answer did discuss the Northern Rap, a fishing lure. However, full credit was not given because the answer did not specifically identify Example 86 in the Sokitome patent but included information about the assignments, which was not considered "material."

Petitioner argues that there is no requirement for an applicant to call to the PTO's attention a portion of a prior art patent. He also urges that the information relating to the assignments is "material", but even if it is not, it would not be improper to include it in the disclosure statement.

Question 5

This question asks the examinees to draft a species claim which would provide for literal infringement of a particular device and explain why the claim is permissible. The model answer assigned 10 points for a claim drawn to a specific embodiment and 5 points for showing its basis in the specification.

The grader deducted 5 points (out of 15) because the petitioner's answer did not cite Example III as support for the added claim. The Director added no points because petitioner's answer, which provided general reasons for the permissibility of filing a preliminary amendment was not equivalent to giving support in the specification for the particular species claim. On reconsideration, the Director maintained his position noting that petitioner's answer did not support his interpretation of this question.

Petitioner argues that the question was ambiguous and that his answer was correct for the question as he interpreted it.

Question 6

This question focuses on obtaining an early application filing date in the PTO when not all the required parts including a filing fee are available.

The grader deducted 3 points (out of 15) because petitioner's answer omitted naming the inventor in the accompanying papers. On his initial review, the Director did not add any points because the inventor's name must be identified. On reconsideration, the Director maintained his position, noting that the fact that model answers to similar questions in prior examinations did not require naming the actual inventor was not controlling in this case.

Petitioner seeks 3 points because the Director's requiring a different answer to substantially the same question on earlier examinations is improper.

DECISION

Question 2

Petitioner bases his argument for 3 points that the PTO policy requiring identification of material portions of a

complex patent, as set forth in MPEP 2002.03, improperly expands the Penn Yan case on which it relies. Although it is recognized that the facts in this question differ from those in Penn Yan, it is submitted that the principle is the same, namely that the applicant has a duty to identify to the PTO which patent of many or what part in a complex patent is material. In this respect, petitioner's attention is invited to a discussion about "burying" prior art in 16 AIPLA Q.J. 48, 49 (1988).

The fact that petitioner also disagrees with the PTO interpretation does not make his answer correct because as the Director pointed out in his decision on reconsideration, examinees were instructed to follow PTO procedures. Further, it would have been appropriate to deduct some additional points for misstatements in petitioner's answer about the inventorship of claim 1 and 2 as noted by the Director in his initial review.

In support of a request for 1 additional point, petitioner has attempted to establish materiality of the facts surrounding the assignments. However, as advised by the Director in both of his decisions, petitioner did not present an adequate basis for materiality. The assignments, however, were material for the fact situation in Question 3 as explained in the model answer to this question. As far as petitioner's suggestion that it is not improper to submit immaterial information to the PTO, this is rejected because irrelevant facts may distract or confuse examiners and would present the same problem created by "burying" the prior art. Further, it is noted the instructions for this question specifically advised "do not include irrelevant information."

Accordingly, no points will be added to this question.

Question 5

Because this question may be considered, in part, to be ambiguous and subject to the interpretation made by petitioner, partial credit is appropriate. However, full credit is not given for petitioner's answer because it did not discuss the "new matter" issue nor show whether there was actual support in the specification for the amendment so that there would not be any "new matter." See 37 CFR 1.118(a). Accordingly, 4 points will be added to petitioner's score.

Question 6

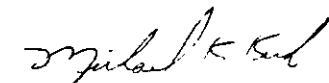
Petitioner has shown that the model answer to this question, which requires that the inventor specifically be named, differs from those in two previous examinations, which did not make the same requirement. Since there does not appear to be any material change in the facts presented or the question asked, three points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of June 3, 1988 is reversed to the extent of restoring seven points deducted by the Director from petitioner's score on the afternoon section of the examination on October 6, 1987. Petitioner, accordingly, has achieved a passing score of 70 points or more in the afternoon section.

The petition is granted.

Dated: Aug 17, 1988



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs